

REMARKS

This invention relates to a process for producing a metal foam in a metal die-casting machine as well as metal bodies produced by this process.

It is believed that no fee is required for the consideration of this Response. If, however, a fee is due, the Director is authorized to charge such fee, or credit any overpayment, to Deposit Account No. 50-0320.

Applicants elect the invention of Group I, claims 1 to 18 and 24 to 42, drawn to a process of making a metal foam. Further, Applicants elect an aluminum as the elected species.

Applicants traverse the Restriction Requirement as the Requirement does not establish that searching all the inventions constitutes an undue burden and is contrary to public policy.

Applicants traverse the Requirement for an Election of Species on the same grounds if the Requirement is being used as a further restriction requirement and will not be modified should the metal be found allowable.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP §803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden,... even though it includes claims to distinct or independent inventions.” *Id.*

Applicants urge that the Restriction Requirement does not meet the second of these criteria as the search for all inventions overlaps. The reason for this is due to the fact that metal bodies are obtained by the process recited in Group I. Thus, the search of the invention of Group I overlaps the search for the inventions of Group II or III as one would search since both areas


are so closely related. With respect to the Requirement for an Election of Species, it is noted that the Requirement does not establish that searching all the metals would establish an undue burden.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as the public. The cost of prosecuting and maintaining so many patents is unreasonable in view of the fact that the groups are closely related. This is especially the situation if the Election of Species is used as an additional restriction requirement. Further, the public is inconvenienced as they will not know whether or not Applicants will file a divisional application to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent application.

Accordingly, in view of the foregoing, reconsideration and modification of this restriction requirement is requested and an early action on the merits is earnestly solicited.

Respectfully submitted,

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